

UNITED STATES PATENT AND
TRADEMARK OFFICE
Trademark Trial and Appeal Board
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wellington

Mailed: May 24, 2005

Opposition No. 91115198

THE VERMONT TEDDY BEAR
COMPANY, INC.

v.

BUILD-A-BEAR WORKSHOP, LLC

Before Quinn, Chapman, and Drost¹,
Administrative Trademark Judges.

By the Board:

On December 17, 2004, the Board granted applicant's motion for summary judgment. In the decision, we found, among other things, that opposer could not establish priority and prove its likelihood of confusion ground for opposition because opposer's own alleged trademark use consisted of a procedure or step of placing a heart-shaped object in a toy animal's chest by a consumer and this cannot be construed as a trademark nor accorded trademark protection under the Trademark Act.

On January 18, 2005, opposer filed a motion for reconsideration of the Board's December 17, 2004 order. In

¹ Judge Drost has been substituted for Judge Simms who has retired from government service.

its brief in support of the motion, opposer essentially argues that the Board's December 17, 2004 decision was premature because there were other grounds for opposition and opposer was entitled to judgment on these other grounds. First, opposer argues that it is entitled to judgment on the ground of "fraud with regard to a declaration signed by the Chief Executive Officer of [applicant], the facts in support of which were only developed after the Board's Suspension Order of June 18, 2004." Second, opposer argues that it is entitled to judgment on the ground that applicant's proposed mark is "(a) equally ornamental as is [opposer's] mark, and (b) in the nature of product design for which no evidence of acquired distinctiveness has been presented."

As to the fraud ground, opposer contends that the notice of opposition contained sufficient allegations setting forth this ground and specifically refers to paragraphs 13 and 14 of the complaint which read, in their entirety, as follows:

13. Opposer believes that opposer is the first user of the Trademark and Service Mark that are the subject of applicant's Trademark/Service Mark application Serial No. 75434462. In applicant's application, a declaration was signed by Manager, Maxine Clark, on behalf of applicant, on February 19, 1998, which declaration included the following averments:

"she believes the applicant to be the owner of the application sought to be registered...she believes the applicant to be entitled to use such mark in commerce...to the best of...her knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when

applied to the goods and services of such other person, to cause confusion, or to cause mistake, or to deceive."

14. On information and belief, when the declaration including the averments set forth in paragraph 13 above was signed, applicant was aware of opposer's prior use of the mark.

Opposer argues that it did not have an opportunity to file a motion for leave to amend the notice of opposition to plead a ground of fraud after taking the deposition of applicant's Chief Executive Officer, Ms. Maxine Clark, because the Board had already issued a suspension order which prohibited the filing of any papers not germane to applicant's summary judgment motion. Specifically, opposer states that because the Board issued the suspension order on June 18, 2004 and the deposition of Ms. Clark took place four days later, opposer "had no opportunity, prior to the Board's decision of December 17, 2004, to move for leave to amend the Notice of Opposition, based upon the new information that came to light during Maxine Clark's deposition, to add a claim for fraud."

Opposer also argues that the Board prematurely dismissed the opposition because opposer is entitled to judgment on the ground that applicant's proposed mark is ornamental and in the nature of a product design without having demonstrated any acquired distinctiveness. Opposer argues that, although applicant's application is based on an intent to use, applicant has in fact been "using its so-called mark prior to the date of filing of its application" and said use is

"identical to the manner in which [opposer] uses the very same alleged mark." Opposer contends that this ground is set forth in paragraph 16 of the notice of opposition, which reads, in its entirety, as follows:

Opposer will be damaged if applicant obtains registration for applicant's mark because such registration would be prima-facie evidence of the validity of the registration, applicant's ownership of applicant's mark, and applicant's exclusive right to use applicant's mark in commerce, when in fact applicant is not entitled to such rights by virtue of opposer's prior continuous use throughout the United States.

Opposer also requests that "if the Board believes that paragraph 16...is not sufficiently clear enough to state this specific ground of opposition,...that the Board vacate its outright dismissal of the opposition proceeding and grant [opposer] leave to amend the notice of opposition to clearly state this ground."

In opposition to opposer's request for reconsideration, applicant argues that opposer "affirmatively admitted that the dismissed [priority and likelihood of confusion] claim was the sole basis of its opposition"; that prior to the request for reconsideration, opposer did not plead or raise the issues of fraud or that applicant's mark is not registrable on the basis that it is merely ornamental and lacks distinctiveness; and that "the Board's decision that [opposer] had no protectable trademark rights in a three-dimensional heart eliminates, as a matter of law, the availability of a fraud claim."

Generally, the premise underlying a motion for reconsideration under 37 CFR §2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. Rather, the motion normally should be limited to a demonstration that, based on the facts before it and the applicable law, the Board's ruling was in error and requires appropriate change. See TBMP §§ 518 and 544 (2d ed. rev. 2004).

Upon review of the parties' arguments and submissions, we find no error in our December 17, 2004 decision. Opposer's notice of opposition to registration of applicant's proposed mark clearly was filed solely under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark, as applied to the goods, so resembles a trademark previously used by opposer, as to be likely to cause confusion, mistake or deception. Opposer's arguments to the contrary, namely, that the notice of opposition also contained allegations setting forth grounds of fraud and that applicant's proposed mark is ornamental and lacks distinctiveness, are not well-taken. Opposer's emphasis and reliance on paragraphs 13, 14 and 16 of the notice of

opposition is misplaced inasmuch these paragraphs merely amplify, at best, the likelihood of confusion ground and do not otherwise, individually or jointly with all other allegations, set forth a separate legally sufficient ground for opposition. Moreover, the parties' briefs on the summary judgment motion are void of any reference to an additional fraud claim or a claim that applicant's mark is ornamental and has not acquired distinctiveness. Rather, opposer conceded that its notice of opposition was filed "asserting Section 2(d) of the Lanham Act as the basis for its opposition - claiming priority of trademark rights based on prior use of a heart located inside a stuffed animal." [P. 3, Opposer's Response to Applicant's Motion for Summary Judgment -- underline added].

Opposer is also mistaken in its assertion that it was prohibited from filing a motion to amend its notice of opposition after the issuance of the Board's June 18, 2004 suspension order. While the Board's suspension order states that parties should only file papers which are germane to the summary judgment motion, section 528.03 of the TBMP clearly provides that "[e]xamples of papers which are or may be germane to a motion for summary judgment include...a motion for leave to amend a party's pleading." See TBMP § 528.03 (2d ed. rev. 2004) which includes citations to the following cases: *International Finance Corp. v. Bravo Co.*, 64 USPQ2d

1597, 1603-04 (TTAB 2002) (motion to amend opposition germane inasmuch as it related to the issue of whether applicant's motion is one for complete or partial summary judgment); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ 1030, 1032 (TTAB 1996) (motion to amend pleading to add new claim); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (motion to amend to amplify pleading).

In summary, it is readily apparent that opposer did not plead any other ground(s) for opposition aside from priority and likelihood of confusion and, if opposer believed it was entitled to judgment on other grounds, it could have, and should have, promptly filed a motion for leave to file an amended notice of opposition. It is too late for the latter course of action. A motion for reconsideration is not a tool for a party to seek adjudication on unpleaded grounds or to request leave to amend its complaint to allege new grounds.

In view thereof, opposer's motion for reconsideration is denied.

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